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7590 McNair Law Firm, P.A. P.O. Box 10827 Greenville, SC 29603-0827				
EXAMINER JOSEPH, TONYA S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/827,188

Applicant(s)

FORRESTER, BRIAN

Examiner

TONYA JOSEPH

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

Claims 1-17 have been previously examined. Claims 1, 6, 9, 12, 14 have been amended. Claim 24 has been added. No claims have been cancelled. Thus, claims 1-17 and 24 are presented for examination.

Response to Arguments

35 USC 101

Applicant argues with respect to claim 1 that the claim is statutory. The Examiner disagrees. Again Applicant's specification includes magnetic signals and Applicant's claim language does not exclude an embodiment of magnetic signals. A transitory, propagating signal is not within any of the four statutory categories of patentable subject matter under § 101. *In re Nuijten*, 84 USPQ2d 1495 (Fed. Cir. 2007). Accordingly, Applicant's arguments are not persuasive and the rejection stands.

35 USC 112 2nd

Claim 1 recites the limitation, "a set of computer readable portable instructions embodied within said first computer readable medium". It is unclear what Applicant regards as "portable instructions". For Examination purposes, Examiner is interpreting instructions on a portable device as meeting this portion of the limitation of the claim. Appropriate Correction is required.

Applicant further asserts that the term, "logical sequence" is indeed defined by the claim and the specification. The Examiner disagrees. Applicant directs the Examiner to the specification para. 10 and 20 to show support for this assertion. ***Examiner notes:***

Para. 10 merely teaches the language of claim 1 and para. 20 simply teaches a system that creates a "fast route" for a technician to follow. The cited paragraph makes no correlation between a logical sequence and a fast route. The term "logical sequence" is a relative term that is not defined by the claim language nor the specification. Accordingly, Applicant's arguments are not persuasive and the rejection is maintained.

Claims 7 and 10 recite the limitation, "scanning the updated meter information...." Although, Applicant describes updated meter information as the new meter information or upgrading a meter with additional components to the host medium, it is unclear exactly what form the information is in (i.e. barcode, indicia etc.) and exactly what information is scanned. For Examination purposes Examiner is interpreting any scanned information as meeting the limitations of this claim. Appropriate Correction is required.
35 USC 103

Applicant argues with respect to claims 1, 9 and 14 that Hoffman teaches away from installing new meters. The Examiner disagrees. The Hoffman reference was relied upon to teach upgrading meters. Milman was relied upon to show replacing customer equipment. Nothing in the Hoffman reference tends to disparage upgrading equipment by replacement or otherwise present the combination with Milman as an unworkable solution. Hoffman merely points out an advantage of its system. "[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed" *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). The disclosure of Hoffman does not rise to the level of a

teaching away. See MPEP §§ 2141.02, 2143.01, and 2145 X.D. for discussion on what constitutes a suitable teaching away.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art at the time of invention would have been motivated to combine the teachings of Milman and Hoffman to provide greater flexibility in metering electricity use, as taught by Milman Col. 2 lines 30-37.

Applicant further argues that Milman does not teach instructions for updating current equipment information with said updated equipment information in said customer information on said host computer readable medium. The Examiner disagrees. Milman teaches a technician ordering replacement parts and generating an invoice for the customer with the replacement information. The Examiner is interpreting the replacement part information as updated equipment information. Applicant further argues that the combination of references does not teach Applicant's newly added claim limitation. The Examiner disagrees. Milman teaches updating and transmitting equipment information concerning the upgrade of one of said old equipment with new equipment (see para. 30). Hoffman further teaches upgrading utility meters.

Applicant further argues that Milman fails to disclose any teachings of utility meters. The Examiner notes: The Hoffman reference was relied upon to teach upgrading meters. Milman was relied upon to show replacing customer equipment. The combination of the two references would have rendered Applicant's invention obvious to one of ordinary skill in the art at the time of invention. Furthermore, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Again, in this case, Milman is directed to maintenance, repair and replacement of customer equipment and Hoffman is directed to upgrading utility meters.

The dependent claims of Applicant's invention are properly rejected at least for the reasons stated above.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 1, 9, 14 and 24 recite the limitation, "a set of computer readable portable instructions embodied within said first computer readable medium". It is unclear what Applicant regards as "portable instructions". For Examination purposes, Examiner is

Art Unit: 3628

interpreting instructions on a portable device as meeting this portion of the limitation of the claim.

4. The term "logical sequence" in claim 2 is a relative term which renders the claim indefinite. The term "logical sequence" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For Examination purposes, Examiner is interpreting any sequence to be logical.

5. Claims 7 and 10 recite the limitation, "scanning the updated meter information...." Although, Applicant describes updated meter information as the new meter information or upgrading a meter with additional components to the host medium, it is unclear exactly what form the information is in (i.e. barcode, indicia etc.) and exactly what information is scanned. For Examination purposes Examiner is interpreting any scanned information as meeting the limitations of this claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5-6, 9, 11-12, 14-15-16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390.

8. As per Claims 1, 9 and 14, Milman teaches a first computer readable medium (see para. 6); a host computer readable medium with the ability to transmit data to and from said first computer readable medium (see para. 6 and para. 9); customer information embodied within said host computer readable medium containing current equipment information and location information for customers (see para. 28);

a set of computer readable host instructions embodied within said host computer readable medium for retrieving said current equipment and location information for customers who have old equipment that require servicing (see para. 28) transmitting said retrieved current equipment and location information to said first computer readable medium(see para. 28); and updating and transmitting equipment information concerning the upgrade of one of said old equipment with new equipment (see para. 30); and

a set of computer readable portable instructions embodied within said first computer readable medium for receiving said retrieved current equipment and location information from said host computer readable medium (see para. 9, 10 and 28); receiving updated equipment information concerning the servicing of one of said equipment with new equipment (see para. 30) and transmitting said updated equipment information concerning the condition to said host computer readable medium (see para. 30)

said set of host computer readable instructions includes instructions for receiving said updated new equipment information from said first computer readable medium; representing serviced equipment (see para. 30), and updating said current equipment

information with said updated equipment information in said customer information on said host computer readable medium (see para. 30).

The sole difference between Milman and the claimed subject matter is that Milman discloses, upgrading and replacing generic customer equipment as opposed to specific utility meters as claimed by Applicant.

Hoffman et al. teaches upgrading utility meters (see Col. 2 lines 16-29).

Since each individual element and its function are shown in the prior art, albeit shown in separate embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution of the utility meters of Hoffman for the customer equipment of Milman. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Milman to include upgrading utility meters as the simple substitution for one known element for another producing a predictable result renders the claim obvious. The limitation, "to reflect updated upgrade status" is merely a statement of intended result and as such is afforded little patentable weight. For all purposes in applying this combination of references, to dependent claims 2-8, servicing equipment will be interpreted as upgrading utility meters, as taught in Hoffman et al. in accordance with rationale stated above.

9. As per Claims 2 and 15, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman further teaches wherein said set of host computer readable instructions includes instructions for creating route information representing a

list of locations where equipment needs to be serviced arranged in a sequence based on said location information (see para. 9 and 28).

10. As per Claims 3 and 16, Milman in view of Hoffman et al. teach the system of claim 2 as described above. Milman further teaches wherein said set of host instructions includes instructions for transmitting said route information to said first computer readable medium (see para. 9).

11. As per Claim 5, Milman in view of Hoffman et al. teach the system of claim 3 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for displaying said route information (see para. 34).

12. As per Claims 6 and 12, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for: displaying a list of options; receiving input representing a selection of an option from a user; and displaying output in response to said selection of option (see para. 36 and Figs. 9-17).

13. As per Claim 11, Milman in view of Hoffman et al. teach the system of claim 9 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for displaying said route information (see para. 34).

14. As per Claim 24, Milman in view of Hoffman teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Hoffman instructions for upgrading said old utility meters with additional components (see Col. 2

lines 39-41 and 52-67). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Milman to include the teachings of Hoffman to provide various upgrading options. Milman teaches a set of computer readable host instructions for receiving updated meter information and a set of computer readable portable instructions for receiving updated meter information.

15. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Official Notice.

16. As per Claim 4, Milman in view of Hoffman et al. teaches the system of claim 3 as described above. Milman does not explicitly teach wherein said set of host instructions include instructions for converting said route information to a format recognizable by said first computer readable medium prior to transmitting said route information to said first computer readable medium. Official Notice is taken that converting information into a recognizable format prior to transmission is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Official Notice to enable reception by a receiving device.

17. As per Claim 17, Milman in view of Hoffman et al. teaches the system of claim 15 as described above. Milman does not explicitly teach wherein said set of host instructions include instructions for converting said route information to a format recognizable by said first computer readable medium prior to transmitting said route information to said first computer readable medium. Official Notice is taken that

converting information into a recognizable format prior to transmission is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Official Notice to enable reception by a receiving device.

18. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Gall et al U.S. Pre-Grant Publication No. 20030163831 A1.

19. As per Claims 7 and 10, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Gall wherein said receiving instructions include scanning instructions for electronically scanning the updated equipment information into said first computer readable medium (see para. 37). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Gall to facilitate troubleshooting, as taught in Gall para. 37.

20. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Smith U.S. Pre-Grant Publication No. 2003/0220737 A1.

21. As per Claims 8 and 13, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Smith wherein said set of portable instructions include GPS instructions for

communicating with a Global Positioning system to obtain accurate information (see para. 25). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffmann to include the teachings of Smith to verify the presence at the customer service location, as taught in Smith para. 25. The limitation, "for locating a utility meter" is merely a statement of intended use and as such is afforded little patentable weight.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-

1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628